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10/065,268	09/30/2002	Akira Ohmura		5678

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EXAMINER

HERNANDEZ, NELSON D

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/065,268

**Applicant(s)**

OHMURA, AKIRA

**Examiner**

Nelson D. Hernandez

**Art Unit**

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/30/05, 7/14/05, 7/14/04, 4/27/04, 1/21/03, 10/21/02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because in fig. 15, step S521, the word "DELETIG" should be written as "DELETING". Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** Claim 9 recites "A computer program product executable by a controller of a digital image storage that can be used with a digital camera..." A computer program product as claimed does not define structural and functional interrelationships between the data structure and the computer software

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and hardware components, which permit the data structure's to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process; therefore the invention as claimed is non-statutory. For examining purposes the claim will be read as "A digital image storage encoded with a computer program that realizes a computer for use with a digital camera..."

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Sarbadhikari, 5,477,264.**

**Regarding claim 1**, Sarbadhikari discloses a digital image storage (see computer in fig. 11: 4 comprising a disk drive 8) for use with a digital camera (Figs. 2 and 10) having a memory (Fig. 2: 24) capable of storing digital data of images and other digital data (enhancement files shown in fig. 2: 24b), the digital image storage comprising: a connector (interface cable shown in fig. 11: 38) for communicating with the digital camera; a controller (CPU shown in fig. 9b) that causes the digital camera to transmit only the digital data of the images, but not the other digital data, from the memory of the digital camera to the digital image storage while the digital camera is

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coupled to the connector (the computer verifies if the memory of the digital camera contains software enhancement algorithms that can be used by the computer, wherein the computer does not download the enhancement files that are no required by the computer, see col. 8, lines 4-23) (Col. 7, line 51 – col. 8, line 49; col. 11, lines 14-42).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari, 5,477,264 in view of Fichtner, 6,256,059 B1.**

**Regarding claim 2**, Sarbadhikari fails to teach that the controller causes the digital camera to transmit the digital data of all the images in the memory to the digital image storage.

However, Fichtner teaches an imaging device (Fig. 1: 10) that is attachable to a host system (Fig. 1: 20) via a cable (Fig. 1: 22), wherein, when the imaging device is attached to the host system, said host system automatically request all the images stored in the imaging device or a particular image (Col. 1, line 66 – col. 2, line 3; col. 2, - lines 14-43 and line 63 – col. 3, line 6; col. 4, lines 17-26). Downloading the image data automatically from the imaging to the host system is advantageous because it frees the

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user from having to select the images to be transmitted in order to transfer said images to the host system, also it would speed up freeing memory space in the imaging device.

Therefore, taking the combined teaching of Sarbadhikari in view of Fichtner as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sarbadhikari by transmitting the digital data of all the images in the memory to the digital image storage when the camera is connected to the storage device. The motivation to do so would have been to help freeing memory space in the digital camera and to reduce the number of operation steps by the user when transferring image data to the storage device.

**Regarding claim 3**, the combined teaching of Sarbadhikari in view of Fichtner as applied to claim 2 teaches that the digital data of the images includes still images and motion picture images (See Fichtner, col. 1, lines 12-21).

**Regarding claim 5**, the combined teaching of Sarbadhikari in view of Fichtner as applied to claim 2 teaches that the controller detects a signal through the connector to cause the transmission of the digital data of the images (See Fichtner, col. 2, lines 30-43).

**9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari, 5,477,264 in view of Davison, US Patent 6,516,099 B1.**

**Regarding claim 4**, Sarbadhikari fails to teach that the controller causes the transmission of the digital data of the images in order of the time when respective digital data of images were taken by the digital camera.

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However, transferring images from a digital camera to an external device in the same order that said images were captured is notoriously well known in the art as taught by Davison wherein a camera (Fig. 1: 12) takes a plurality of images and a computer (Fig. 1: 12) downloads said images in the same order said images were taken in order to display the images in a display (Fig. 1: 18) in the same order the images were taken (Col. 7, lines 34-60).

Therefore, taking the combined teaching of Sarbadhikari in view of Davison as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the digital image storage system in Sarbadhikari by taking out of the digital images in order of the time when respective digital images were taken by the digital camera. The motivation to do so would have been to help the digital image storage organizing the images when having a large amount of images stored in the digital camera or the digital image storage, this would also help the user to better determine the age of the images.

**10. Claim 6, 7-10 and 14-18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari, 5,477,264 in view of Berstis, US Patent 6,721,001 B1.**

**Regarding claim 6,** Sarbadhikari fails to teach that the connector includes a docking station for coupling with the digital camera.

However, Berstis discloses a digital image storage system (See fig. 1) for use with a digital camera (Fig. 1: 102) having a memory (Fig. 2: 214), the digital image storage system comprising: a docking station (Fig. 1: 106) on which the digital camera

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is to be placed for taking out digital images stored in the memory of the digital camera; and a digital image storage (Personal computer; col. 2, lines 15-46) located apart from the docking station for communicating with the docking station, wherein the digital camera includes a controller (Fig. 2: 208) that detects a signal from the docking station and causes transmission of the digital images subsequent to receipt of the signal (Col. 2, line 15 - col. 3, line 8; col. 4, lines 5-63).

Therefore, taking the combined teaching of Sarbadhikari in view of Berstis as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sarbadhikari by having the digital images in the memory being transmitted from the memory to the digital image storage by way of a docking station and detecting said docking station in order to transmit the images to said digital image storage from said digital camera. The motivation to do so would have been to alleviate the need to use a cable to connect the camera to the host, as is done with other digital still cameras and which may require restarting the local host to recognize the newly connected camera, this would also improve the operability and reduce the time needed to connect a camera to a host.

**Regarding claim 7**, the combined teaching of Sarbadhikari in view of Berstis teaches that the docking station charges a battery of the digital camera while the digital camera is coupled to the docking station (See Berstis, col. 2, lines 15-39).

**Regarding claim 8**, the combined teaching of Sarbadhikari in view of Berstis teaches that a signal that causes the controller to start the transmission of the digital



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data of the images is output from the docking station after the coupling of the digital camera with the docking station (See Berstis, col. 4, lines 35-63).

**Regarding claim 9**, Sarbadhikari discloses a digital image storage encoded with a computer program that realizes a computer (see computer in fig. 11: 4 comprising a disk drive 8) for use with a digital camera (Figs. 2 and 10) having a memory (Fig. 2: 24) capable of storing digital data of images and other digital data (enhancement files shown in fig. 2: 24b), the digital data of the images being transmitted from the digital camera memory to the digital image storage by way of a connector (interface cable shown in fig. 11: 38) capable of being coupled with the digital camera, the computer program product storing a program comprising instruction to cause the controller (CPU shown in fig. 9b) to perform the steps of: performing the transmission of the digital data of the images, but not the other digital data from the memory of the digital camera is coupled to the digital image storage through the connector; and storing the transmitted digital data of the images in the digital image storage (Col. 7, line 51 – col. 8, line 49; col. 11, lines 14-42).

Sarbadhikari fails to teach a docking station and the step of detecting receipt of a signal from the docking station to initiate the transmission of the digital data memory of the digital camera to the digital image storage in response to the signal.

However, Berstis discloses a digital image storage system (See fig. 1) for use with a digital camera (Fig. 1: 102) having a memory (Fig. 2: 214), the digital image storage system comprising: a docking station (Fig. 1: 106) on which the digital camera is to be placed for taking out digital images stored in the memory of the digital camera;

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and a digital image storage (Personal computer; col. 2, lines 15-46) located apart from the docking station for communicating with the docking station, wherein the digital camera includes a controller (Fig. 2: 208) that detects a signal from the docking station and causes transmission of the digital images subsequent to receipt of the signal (Col. 2, line 15 - col. 3, line 8; col. 4, lines 5-63).

Therefore, taking the combined teaching of Sarbadhikari in view of Berstis as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sarbadhikari by having the digital images in the memory being transmitted from the memory to the digital image storage by way of a docking station and detecting said docking station in order to transmit the images to said digital image storage from said digital camera. The motivation to do so would have been to alleviate the need to use a cable to connect the camera to the host, as is done with other digital still cameras and which may require restarting the local host to recognize the newly connected camera, this would also improve the operability and reduce the time needed to connect a camera to a host.

**Regarding claim 10**, Sarbadhikari discloses a digital image storage system for use with a digital camera (Figs. 2 and 10) having a memory (Fig. 2: 24) capable of storing digital data of images and other digital data (enhancement files shown in fig. 2: 24b), the system comprising: an image storage (see computer in fig. 11: 4 comprising a disk drive 8) in communication with the docking station, the image storage including a storage medium (disk drive 8), and a controller (CPU shown in fig. 9b) that causes the transmission of digital data of the digital camera through a connector (interface cable

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shown in fig. 11: 38) and to the storage medium of the image storage while the digital camera is connected to the image storage (Col. 7, line 51 – col. 8, line 49; col. 11, lines 14-42).

Sarbadhikari fails to teach a docking station on which the digital camera can be placed to communicate with the digital camera; and that the controller causes the transmission of digital data of the digital camera through the docking station and to the storage medium of the image storage while the digital camera is placed on the docking station.

However, Berstis discloses a digital image storage system (See fig. 1) for use with a digital camera (Fig. 1: 102) having a memory (Fig. 2: 214), the digital image storage system comprising: a docking station (Fig. 1: 106) on which the digital camera is to be placed for taking out digital images stored in the memory of the digital camera; and a digital image storage (Personal computer; col. 2, lines 15-46) located apart from the docking station for communicating with the docking station, wherein the digital camera includes a controller (Fig. 2: 208) that detects a signal from the docking station and causes transmission of the digital images subsequent to receipt of the signal (Col. 2, line 15 - col. 3, line 8; col. 4, lines 5-63).

Therefore, taking the combined teaching of Sarbadhikari in view of Berstis as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sarbadhikari by having the digital images in the memory being transmitted from the memory to the digital image storage by way of a docking station and detecting said docking station in order to transmit the images to said digital

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image storage from said digital camera. The motivation to do so would have been to alleviate the need to use a cable to connect the camera to the host, as is done with other digital still cameras and which may require restarting the local host to recognize the newly connected camera, this would also improve the operability and reduce the time needed to connect a camera to a host.

**Regarding claim 14**, the combined teaching of Sarbadhikari in view of Berstis teaches that the controller detects a signal that causes the controller to start the transmission of the digital data of the images (See Berstis, col. 4, lines 35-63).

**Regarding claim 15**, the combined teaching of Sarbadhikari in view of Berstis teaches that the docking station charges a battery of the digital camera while the digital camera is coupled to the docking station (See Berstis, col. 2, lines 15-39).

**Regarding claim 16**, the combined teaching of Sarbadhikari in view of Berstis teaches that a signal causes the controller to start the transmission of the digital data of the images is output from the docking station after the placement of the digital camera on the docking station (See Berstis, col. 4, lines 35-63).

**Regarding claim 17**, the combined teaching of Sarbadhikari in view of Berstis teaches that the docking station has a shape to fit a bottom of the digital camera (See fig. 1, docking station 106 has a shape to fit a bottom of the digital camera 102).

**Regarding claim 18**, the combined teaching of Sarbadhikari in view of Berstis teaches that the docking station has a shape to fit a bottom of the digital camera (See fig. 1, docking station 106 has a shape to fit a bottom of the digital camera 102).

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**11. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari, 5,477,264 in view of Berstis, US Patent 6,721,001 B1 in view of Fichtner, 6,256,059 B1.**

Regarding claim 11, the combined teaching of Sarbadhikari in view of Berstis fails to teach that the controller causes the digital camera to transmit the digital data of all the images in the memory to the image storage.

However, Fichtner teaches an imaging device (Fig. 1: 10) that is attachable to a host system (Fig. 1: 20) via a cable (Fig. 1: 22), wherein, when the imaging device is attached to the host system, said host system automatically request all the images stored in the imaging device or a particular image (Col. 1, line 66 – col. 2, line 3; col. 2, - lines 14-43 and line 63 – col. 3, line 6; col. 4, lines 17-26). Downloading the image data automatically from the imaging to the host system is advantageous because it frees the user from having to select the images to be transmitted in order to transfer said images to the host system, also it would speed up freeing memory space in the imaging device.

Therefore, taking the combined teaching of Sarbadhikari in view of Berstis and further in view of Fichtner as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the storage system in Sarbadhikari and Berstis by transmitting the digital data of all the images in the memory to the digital image storage when the camera is connected to the storage device. The motivation to do so would have been to help freeing memory space in the digital camera and to reduce the number of operation steps by the user when transferring image data to the storage device.

*Berstis and*

**Regarding claim 12**, the combined teaching of Sarbadhikari in view of <sup>A</sup>Fichtner as applied to claim 11 teaches that the digital data of the images includes still images and motion picture images (See Fichtner, col. 1, lines 12-21).

**12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari, 5,477,264 in view of Berstis, US Patent 6,721,001 B1 and further in view of Davison, US Patent 6,516,099 B1.**

**Regarding claim 13**, the combined teaching of Sarbadhikari in view of Berstis fails to teach that the controller causes the transmission of the digital data of the images in order of the time when respective digital data of images were taken by the digital camera.

However, transferring images form a digital camera to an external device in the same order that said images were captured is notoriously well known in the art as taught by Davison wherein a camera (Fig. 1: 12) takes a plurality of images and a computer (Fig. 1: 12) downloads said images in the same order said images were taken in order to display the images in a display (Fig. 1: 18) in the same order the images were taken (Col. 7, lines 34-60).

Therefore, taking the combined teaching of Sarbadhikari in view of Berstis and further in view of Davison as a whole, it would have been obvious to one of ordinary skill in the art ~~at~~ the time the invention was made to modify the digital image storage system in Sarbadhikari and Berstis by taking out of the digital images in order of the time when respective digital images were taken by the digital camera. The motivation to do so would have been to help the digital image storage organizing the images when having a

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large amount of images stored in the digital camera or the digital image storage, this would also help the user to better determine the age of the images.

### **Contact**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson D. Hernandez whose telephone number is (571) 272-7311. The examiner can normally be reached on 8:30 A.M. to 6:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc Yen Vu can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NDHH  
November 22, 2005

Nelson D. Hernandez  
Examiner  
Art Unit 2612

  
NGOC YEN VU  
PRIMARY EXAMINER